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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,124	01/09/2002	Franz Kunisch	MO-6598/LEA 33,210	9416

26694 7590 10/19/2004

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EXAMINER

MCKANE, ELIZABETH L

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/936,124

Applicant(s)

KUNISCH ET AL.

Examiner

Leigh McKane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13 and 15-21 is/are allowed.
- 6) ☒ Claim(s) 8, 10, 14 and 22 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 080304.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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***Claim Rejections - 35 USC § 102***

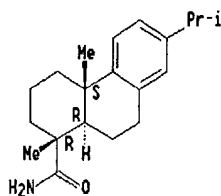
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by CAS Registry # 35928-32-6.

Registry # 35928-32-6 is the following compound, which was entered into the STN database on 16 November 1984:

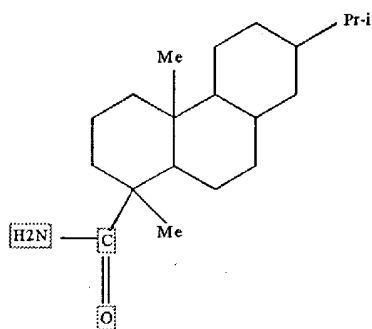


The above compound reads on the instant claims when the claimed formula is I8, when  $n=0$  and wherein:  $R^1$  is  $NR^2R^3$ ;  $R^2$  is a hydrogen atom;  $R^3$  is  $C=OR^4$ ; and  $R^4$  is a hydrogen atom.

3. Claims 8-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by CAS Registry # 73757-72-9.

Registry # 73757-72-9 is the following compound, which was entered into the STN database on 16 November 1984:

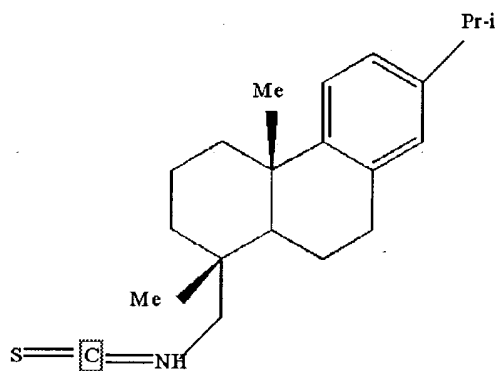
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The above compound reads on the instant claims when the claimed formula is II, when  $n=0$  and wherein:  $R^1$  is  $NR^2R^3$ ;  $R^2$  is a hydrogen atom;  $R^3$  is  $C=OR^4$ ; and  $R^4$  is a hydrogen atom.

4. Claims 8, 9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by CAS Registry # 115269-93-7.

Registry # 115269-93-7 is the following compound, which was entered into the STN database on 16 July 1988:

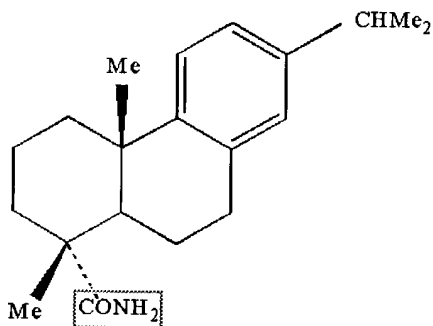


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The above compound reads on the instant claims when the claimed formula is I8, when  $n=1$  and wherein  $R^1$  is an isothiocyanate group.

5. Claims 8-10, 14, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Akatsuka et al (abstract of JP 63-017806).

Akatsuka et al teaches that the compound below was known as of 25 January 1988.



The above compound reads on the instant claims when the claimed formula is I8, when  $n=0$  and wherein:  $R^1$  is  $NR^2R^3$ ;  $R^2$  is a hydrogen atom;  $R^3$  is  $C=OR^4$ ; and  $R^4$  is a hydrogen atom.

### *Claim Objections*

6. The use of the trademark/tradenames diuron, endothal, dichorophen, etc. has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

*Allowable Subject Matter*

7. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 11-13 and 15-21 are allowed.

*Response to Arguments*

9. Applicant's arguments filed 21 April 2004 have been fully considered but they are not persuasive.
10. In response to Applicant's argument that the CAS registry numbers cited in the office action do not satisfy the written description and enable requirements, the Examiner notes that the Stockel ("The Preparation of Dehydroabietane-1-Amine" and Rane et al ("New Strategies for the Hofmann Reaction") references, both cited by Applicant, illustrate how one of ordinary skill in the art may prepare these amines. Thus, at the time of the instant invention, it was known how to make the claimed compounds.

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

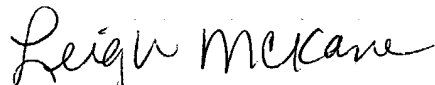
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 571-272-1275. The examiner can normally be reached on Monday-Wednesday (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 571-272-1275. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.

  
**Leigh McKane**  
**Primary Examiner**  
**Art Unit 1744**

elm  
18 October 2004